

## B. REMARKS

By this amendment, Claims 2 and 43 have been canceled and Claims 1 and 42 amended. Hence, Claims 1, 3-42 and 44-84 are pending in this application. The amendments to the claims do not add any new matter to this application. All issues raised in the Final Office Action mailed April 28, 2005 are addressed hereinafter.

### REJECTION OF CLAIMS 1-5, 7, 8-20, 29, 42-46, 48-61, 70 AND 83 UNDER 35 U.S.C. § 103(a)

In the Final Office Action, Claims 1-5, 7, 8-20, 29, 42-46, 48-61, 70 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess et al.*, U.S. Patent No. 5,696,701 (hereinafter "*Burgess*") in view of *Grimm et al.*, U.S. Patent No. 6,317,868 (hereinafter "*Grimm*"). This rejection is now moot with respect to canceled Claims 2 and 43. It is respectfully submitted that Claims 1, 3-5, 7, 8-20, 29, 42, 44-46, 48-61, 70 and 83, as amended, are patentable over *Burgess* and *Grimm* for at least the reasons provided hereinafter.

#### CLAIM 1

Claim 1, as amended, is directed to a method for measuring client side performance that recites:

“intercepting an item generated by an application program and that is to be sent to a client process prior to arrival of the item at the client process;  
modifying the item transparently with respect to the application program to produce a modified item that includes code which causes one or more processors on a client device to perform the steps of:  
measuring performance related to a service associated with the item, and  
performing one or more acts based on a measurement resulting from said step of measuring performance; and  
sending the modified item to the client process.”

It is respectfully submitted that Claim 1 is patentable over *Burgess* and *Grimm* because Claim 1 recites one or more limitations that are not taught or suggested by *Burgess* or *Grimm*, considered alone or in combination. For example, it is respectfully submitted that the Claim 1 limitations “intercepting an item generated by an application program and that is to be sent to a client process prior to arrival of the item at the client process” and “modifying the item transparently with respect to the application program to produce a modified item” are not taught or suggested by *Burgess* and *Grimm*, considered alone or in combination. The Final Office Action asserted that these limitations are not taught or suggested by *Burgess* and relied upon *Grimm* for these limitations. No further discussion of *Burgess* is therefore provided with respect to these limitations.

*Grimm* describes an approach for modifying a software component to implement a security policy defined for a site where the software component is executed. When a software component needs to be loaded for execution, i.e., linked and activated, by a computer, an introspection service 13 intercepts the software component for analysis. An interposition service 17 modifies the software component to adhere to the security policies of the computer. This includes adding code to the original software component to generate a modified software component 21. The modified software component 21 is then loaded and made available for execution in place of the original software component. When executed, the modified software component 21 invokes the necessary security services, which maintains the security state of the computer.

It is noted from the Final Office Action that the original software component of *Grimm* is considered to be the “item” recited in Claim 1. One distinction between the approach recited in Claim 1 and the teachings of *Grimm* is that Claim 1, as amended, recites that the item be

generated by an application program. Furthermore, the item must be modified “transparently with respect to the application program.” There is no teaching or suggestion in *Grimm* that the software component is generated by an application program and then modified “transparently with respect to the application program.” *Grimm* describes only that the original software component is modified by the interposition service inserting code into the original software component.

In view of the foregoing, it is therefore respectfully submitted that Claim 1, as amended, recites one or more limitations that are not taught or suggested by *Burgess* and *Grimm*, considered alone or in combination, and that Claim 1 is therefore patentable over *Burgess* and *Grimm*.

#### CLAIMS 3-5, 7, 8-20 AND 29

Claims 3-5, 7, 8-20 and 29 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 3-5, 7, 8-20 and 29 are patentable over *Burgess* and *Grimm* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 3-5, 7, 8-20 and 29 recite additional limitations that independently render them patentable over *Burgess* and *Grimm*.

For example, Claim 18 recites “determining a type associated with the item; and determining whether to perform said step of modifying the item based on the type of the item.” *Grimm* describes determining whether to generate a modified software component based upon information determined by introspection service 13. More specifically, security policy service 15 determines the security policy that is applicable to the software component. *Grimm* does not teach or suggest, however, determining whether to generate a modified software component based upon a type associated with the software component. Since there are many ways this

could be done, in the absence of some teaching or suggestion of using a type associated with a software component to determine whether to generate a modified software component, it is respectfully submitted that the additional limitations recited in Claim 18 are not taught or suggested by *Grimm*.

#### CLAIMS 42, 44-46, 48-61, 70 AND 83

Claims 42, 44-46, 48-61, 70 and 83 are similar to Claims 1, 3-5, 7, 8-20 and 29, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 42, 44-46, 48-61, 70 and 83 are patentable over *Burgess* and *Grimm* for at least the reasons set forth herein with respect to Claims 1, 3-5, 7, 8-20 and 29.

In view of the foregoing, it is respectfully submitted that Claims 1, 3-5, 7, 8-20, 29, 42, 44-46, 48-61, 70 and 83, as amended, are patentable over *Burgess* and *Grimm*.

#### REJECTION OF CLAIMS 6 AND 47 UNDER 35 U.S.C. § 103(a)

In the Final Office Action, Claims 6 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Dustan et al.*, U.S. Patent No. 5,884,312 (hereinafter "*Dustan*"). It is respectfully submitted that Claims 6 and 47 are patentable over *Burgess*, *Grimm* and *Dustan*, considered alone or in combination, for at least the reasons provided hereinafter.

Claim 6 depends from Claim 1 and includes all of the limitations of Claim 1. Claim 47 recites limitations similar to Claim 6, except in the context of a computer-readable medium. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Dustan* and it is understood that *Dustan* was relied upon in the Office Action for the limitations of Claim 6 and not for the limitations of Claim 1. *Dustan* describes an

approach for securely accessing information from disparate data sources through a network. There is no description or suggestion in *Dustan*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is therefore respectfully submitted that Claims 6 and 47 are not taught or suggested by *Burgess*, *Grimm* and *Dustan*, considered alone or in combination, and that Claims 6 and 47 are therefore patentable over *Burgess*, *Grimm* and *Dustan*.

#### **REJECTION OF CLAIMS 24-27 AND 65-68 UNDER 35 U.S.C. § 103(a)**

In the Final Office Action, Claims 24-27 and 65-68 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Simonoff et al.*, U.S. Patent No. 5,944,784 (hereinafter “*Simonoff*”). It is respectfully submitted that Claims 24-27 and 65-68 are patentable over *Burgess*, *Grimm* and *Simonoff*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 24-27 depend from Claim 1 and include all of the limitations of Claim 1. Claims 65-68 recite limitations similar to Claims 24-27, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Simonoff* and it is understood that *Simonoff* was relied upon in the Office Action for the limitations of Claims 24-27 and not for the limitations of Claim 1. *Simonoff* describes operating methods for a universal client device. There is no description or suggestion in *Simonoff*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is

therefore respectfully submitted that Claims 24-27 and 65-68 are not taught or suggested by *Burgess, Grimm and Simonoff*, considered alone or in combination, and that Claims 24-27 and 65-68 are therefore patentable over *Burgess, Grimm and Simonoff*.

**REJECTION OF CLAIMS 28, 30, 69 AND 71 UNDER 35 U.S.C. § 103(a)**

In the Final Office Action, Claims 28, 30, 69 and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Hoskins et al.*, U.S. Patent No. 6,108,662 (hereinafter "*Hoskins*"). It is respectfully submitted that Claims 28, 30, 69 and 71 are patentable over *Burgess, Grimm and Hoskins*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 28 and 30 depend from Claim 1 and include all of the limitations of Claim 1. Claims 69 and 71 recite limitations similar to Claims 28 and 30, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess and Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Hoskins* and it is understood that *Hoskins* was relied upon in the Office Action for the limitations of Claims 28 and 30 and not for the limitations of Claim 1. *Hoskins* describes a system software solution for controlling an enterprise. There is no description or suggestion in *Hoskins*, however, of "intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item" and "sending the modified item to the client process," as recited in Claim 1. It is therefore respectfully submitted that Claims 28, 30, 69 and 71 are not taught or suggested by *Burgess, Grimm and Hoskins*, considered alone or in combination, and that Claims 28, 30, 69 and 71 are therefore patentable over *Burgess, Grimm and Hoskins*.

### **REJECTION OF CLAIMS 31, 32, 72 AND 73 UNDER 35 U.S.C. § 103(a)**

In the Final Office Action, Claims 31, 32, 72 and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Nasu et al.*, U.S. Patent No. 5,671,402 (hereinafter “*Nasu*”). It is respectfully submitted that Claims 31, 32, 72 and 73 are patentable over *Burgess*, *Grimm* and *Nasu*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 31 and 32 depend from Claim 1 and include all of the limitations of Claim 1. Claims 72 and 73 recite limitations similar to Claims 31 and 32, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Nasu* and it is understood that *Nasu* was relied upon in the Office Action for the limitations of Claims 31 and 32 and not for the limitations of Claim 1. *Nasu* describes a method for evaluating a data processing rate using simulation. There is no description or suggestion in *Nasu*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is therefore respectfully submitted that Claims 31, 32, 72 and 73 are not taught or suggested by *Burgess*, *Grimm* and *Nasu*, considered alone or in combination, and that Claims 31, 32, 72 and 73 are therefore patentable over *Burgess*, *Grimm* and *Nasu*.

### **REJECTION OF CLAIMS 33-41, 74-82 AND 84 UNDER 35 U.S.C. § 103(a)**

In the Final Office Action, Claims 33-41, 74-82 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Raz et al.*, U.S. Pub. No. 2001/0037400 A1 (hereinafter “*Raz*”). It is respectfully submitted that Claims 33-

41, 74-82 and 84 are patentable over *Burgess*, *Grimm* and *Raz*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 33-41 depend from Claim 1 and include all of the limitations of Claim 1. Claims 74-82 and 84 recite limitations similar to Claims 33-41, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Raz* and it is understood that *Raz* was relied upon in the Office Action for the limitations of Claims 33-41 and not for the limitations of Claim 1. *Raz* describes a method for decreasing the user-perceived system response time in Web-based systems. There is no description or suggestion in *Raz*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is therefore respectfully submitted that Claims 33-41, 74-82 and 84 are not taught or suggested by *Burgess*, *Grimm* and *Raz*, considered alone or in combination, and that Claims 33-41, 74-82 and 84 are therefore patentable over *Burgess*, *Grimm* and *Raz*.



## CONCLUSION

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Edward A. Becker

Reg. No. 37,777

Date: August 16, 2005

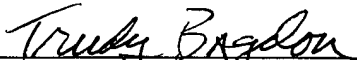
2055 Gateway Place, Suite 550  
San Jose, CA 95110  
(408) 414-1204  
Facsimile: (408) 414-1076

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop RCE**, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on August 16, 2005

by

  
Trudy Bagdon